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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,139	03/30/2004	Lydie Poitout	427.054-DIV.	5412
47888	7590	02/08/2006	EXAMINER	
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			HABTE, KAHSAY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/813,139

Applicant(s)

POITOUT ET AL.

Examiner

Kahsay Habte

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/29/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/048,144.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 15-24 are pending in this application.

Response to Amendment

2. Applicant's amendment filed 12/29/05 in response to the previous Office Action (08/26/2005) is acknowledged. Rejection of claims 15-23 and 25 under 35 U.S.C. § 112, second paragraph (paragraph 6b) has been obviated. The second paragraph rejections (items 6a and 6c) have been maintained.

Claim objections

3. Claim 15 is objected to because the term "benzo[b]furannyl" is a typo. This term in claim 15 (page 5, line 2) should read as "benzo[b]furanyl".

Response to arguments

Applicant's argument filed 12/29/2005 has been fully considered but it is not persuasive.

Applicants have fixed this term in claim 18 and 25, but this typo was also in claim 15.

4. In claim 15 (page 3, line 3), there is a period in the middle of the claim. The period after term "phthalimidoalkyl." should be removed.

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5. Claim 23 is objected to because of recitation of the phrase “for treating disorders...” is improper. Note that claim 23 is a composition claim and not a method of use claim. If applicants intend a method claim, then the claim should be written in a method of use claim language. It is recommended that applicants delete the intended use from claim 23.

Response to arguments

Applicant's argument filed 12/29/2005 has been fully considered but it is not persuasive.

Applicants believe that the composition claim is proper, but give no reason why the composition claim is proper or why the objection is improper. Note that the method claims are restricted out and are not examined until the product is found allowable. The examiner definitely would reject claim 24 (method of use) under 112 first paragraph rejection (enablement) after the condition for the rejoinder are met. Thus, the intended use on a composition is improper. The examiner recommends that applicants delete the intended use from the composition claim 23.

Specification

6. The abstract of the disclosure is objected to because there the terms “benzo[b]furannyl” or “furannyl” are typographic errors. Applicants have to fix these typographical problems in the specification. For example, see page 5 (line 2) of the specification. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claim 15 (page 3, lines 1-2), the phrase “benzothiophenyl and phthalimidyl and carbocyclic aralkyl and heterocyclic aralkyl are selected from the group consisting of benzyl, phenylethyl.....” is confusing. Applicants have recited specific rings such as benzyl, phenylpropyl,....and phthalimidoalkyl, but it is unclear if said rings belong to heterocyclic aralkyl or to carbocyclic aralkyl. It is also unclear where the end of the definition of Z2 is. There is the term “and” in three places. It is recommended that applicants separate the definition of carbocyclic aralkyl from heterocyclic aralkyl and amend the claim as “benzofuranyl, benzothiophenyl, phthalimidyl, carbocyclic aralkyl selected from benzyl, phenylethyl and phenyl butyl, and heterocyclic aralkyl are selected from indolylalkyl and phthalimidoalkyl”.

b. Claim 15 and claims dependent thereon are rejected because the phrase “substituted carbocyclic or heterocyclic aryl” is indefinite. In the absence of the specific

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moieties intended to effectuate modification by the "substitution" or attachment to the chemical core claimed, the term "substituted" renders the claims in which it appears indefinite in all occurrences wherein applicants fails to articulate by chemical name, structural formula or sufficiently distinct functional language, the particular moieties applicants regards as those which will facilitate substitution, requisite to identifying the composition of matter claimed.

Response to arguments

Applicant's argument filed 12/29/2005 has been fully considered but it is not persuasive.

Applicants have amended "substituted radical" to "substituted group", but did not address this issue. The examiner has raised this issue before (see item 6c). Applicants have to recite any substituents on aryl, carbocyclic or heterocyclic aryl or on any other groups to overcome this rejection

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Kahsay Habte', is positioned above the printed name.

Kahsay Habte
Primary Examiner
Art Unit 1624

KH
February 6, 2006